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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.      |
|---|-------------|----------------------|---------------------|-----------------------|
| 09/469,987  | 12/21/1999  | MARK L. SKARPNESS    | 10559/094001        | 5632                  |
| 8791  | 7590        | 02/10/2006           | EXAMINER            |                       |
| BLAKELY SOKOLOFF TAYLOR & ZAFMAN<br>12400 WILSHIRE BOULEVARD<br>SEVENTH FLOOR<br>LOS ANGELES, CA 90025-1030 |             |                      |                     | NGUYEN, PHUONGCHAU BA |
| ART UNIT  |             | PAPER NUMBER         |                     |                       |
|   |             |                      |                     | 2665                  |

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/469,987             | SKARPNESS, MARK L.  |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Fuongchau Ba Nguyen    | 2665                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 9-9-5.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 20-23 and 32-39 is/are pending in the application.
- 4a) Of the above claim(s) 24-31 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 20-23 and 32-39 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

***Claim Rejections – 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 20, 22, 32, 36–39 rejected under 35 U.S.C. 103(a) as being unpatentable over Eames (6,208,637) in view of Roger (6,346,964).

**Regarding claims 20, 32, 36–39:**

Eames (6,208,637) discloses a telephony over broadband telephony adapter (combined data and telephony 1604, fig.16b); comprising:  
a device controller (1622, fig.16b) to couple to a host controller (1700) of a broadband modem (ADSL modem 1600, fig.17);  
a modulator (code 1640, fig.16b) to modulate telephony information;  
a transcoder (1638, fig.16b) to transcode information between said device controller and said modulator; and

one or more subscriber line interface circuits (SLIC 1640, fig.16b) to couple one or more telephony devices (to telephone via RJ11) to said modulator; and

a memory device (flash 1634–fig.16b) which connected to the device controller (1622);

an expansion port (twisted pair drop cable 180–fig.16b) to include a signal to carry information (of devices connecting to the second adapter via the other USAM 340–fig.3) not associated with the one or more telephone numbers that are to be serviced by the broadband telephony adapter (the first adapter 1604, fig.16b) to a second broadband telephony adapter (the second adapter, not shown, that could connect to the other USAM 340–fig.3)

wherein the one or more telephony devices are able to communicate over a broadband line (180, figs.16) via the broadband modem (1602) by communicating via the host controller (1700) of the broadband modem (1600).

Eames does not explicitly (1) a memory device (flash 1634–fig.16b) to store one or more telephone numbers that are to be serviced by the broadband telephony adapter, wherein the device controller (1622) separates information

associated with the one or more telephone numbers, and wherein the one or more telephone numbers are associated with the one or more telephony devices, wherein an additional telephone number to be serviced by the broadband telephony adapter may be obtained by programming the additional number into the memory device; (2) wherein a new telephone number maybe added to be serviced by the broadband telephony adapter by programming the new telephone number into the memory device; (3) wherein the separated information associated with the one or more telephone numbers is forwarded to the one or more telephony devices associated with the one or more telephone numbers.

However, in the same field of endeavor, Roger (6,346,964) discloses in figure 2 "telephone numbers associated with each party can be stored in a memory associated with controller 257-fig.2 for reference. A displayable address book can be provided to store names, addresses and other information such as a digitized bitmap image of each user,"(corresponding to (1-3)). Therefore, it would have been obvious to an artisan to provide high quality

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audio, data and video teleconferencing between two or more telephone users in an office connected through a telephone switch such as PBX.

**Regarding claim 22:**

Eames further comprises an expansion hub (BDT 130, fig.3) to connect additional devices (in the new network, i.e., ATM network) to the host controller via the expansion hub.

3. Claims 21, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eames (6,208,637) in view of Roger (6,346,964) as applied to claim 20 above, and further in view of Barzegar (6,347,075).

**Regarding claims 21, 34:**

Eames does not explicitly disclose wherein said device controller (1622, fig.16b) is configured to operate in compliance with one of a Universal Serial Bus standard, a Firewire standard, and a wireless communication standard. However, in the same field of endeavor, Barzegar (6,347,075) discloses in figure 2 IEEE 1394 112 (firewire). Therefore, it would have been obvious to an

artisan to apply Barzegar's teaching to Eames' system with the motivation being to allow incorporating the desired processing digital data onto the data network.

4. Claims 23, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eames (6,208,637) in view of Roger (6,346,964) as applied to claim 20 above, and further in view of Bauer (6,061,450).

Regarding claims 23, 35:

Eames does not explicitly disclose wherein the telephony device is able to communicate via the host controller of the broadband modem **via wireless transmission** between the telephony device and the broadband telephony adapter. However, in the same field of endeavor, Bauer (6,061,450) discloses wherein the telephony device is able to communicate via the host controller of the broadband modem **via wireless transmission** between the telephony device and the broadband telephony adapter {figure 5, 202, 507}. Therefore, it would have been obvious to an artisan to apply Bauer's teaching to Eames' system

with the motivation being to provide long distance call routing utilizing the wireless connection.

5. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eames (6,208,637) in view of Roger (6,346,964) as applied to claim 20 above, and further in view of Bhatia (6,118,768).

**Regarding claim 33:**

Eames discloses wherein the telephony adapter (1604, fig.16b) has a telephone number associated therewith (inherent with the telephone, fig.16b).

Eames does not explicitly wherein said hub circuit (Ethernet hub) routes telephony information associated with telephony adapter to the first telephony device, and routes other telephony information to the at least one additional telephony device. However, in the same field of endeavor, Bhatia (6,118,768) discloses wherein said hub circuit (Ethernet hub, 340, fig.1) routes telephony information associated with telephony adapter to the first telephony device, and routes other telephony information to the at least one additional telephony device {fig.1}. Therefore, it would have been obvious to an artisan to apply

Bhatia's teaching to Eames' system with the motivation being to bi-directionally route digital on either or both B-channels of ISDN connection between PSTN and analog telephone devices.

***Response to Arguments***

6. Applicant's arguments filed 10-26-5 have been fully considered but they are not persuasive.

A/. Applicant argued that the combination of Eames (6,208,637) and Rogers (6,346,964) does not disclose "wherein an additional telephone number to be serviced by the broadband telephony adapter may be obtained by programming the additional number into the memory device".

In reply, applicant is directed to figure 2 wherein there are telephone numbers associated with each party can be stored in a memory associated with controller 257 for reference. Thus, saving another telephone number into the memory device to be used later by a user party is a common practice.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuongchau Ba Nguyen whose

telephone number is 571-272-3148. The examiner can normally be reached on Monday-Friday from 10:00 a.m. to 2:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 571-272-3155. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DUCHO  
PRIMARY EXAMINER



02-07-06

PN  
Phuongchau Ba Nguyen  
Examiner  
Art Unit 2665